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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,374	01/31/2000	Cesar Compadre	23533/119	3327

7590 01/30/2002  
FOLEY & LARDNER  
3000 K STREET N W SUITE 500  
Washington, DC 20007-5109

EXAMINER

WARE, TODD

ART UNIT PAPER NUMBER

1615

DATE MAILED: 01/30/2002~

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/494,374

Applicant(s)

COMPADRE ET AL.

Examiner

Todd D Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35, 37-39 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35, 37-39 and 47-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10, 11
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Receipt of information disclosure statements filed 7-2-01 and 8-22-01 and request for extension of time (granted) and amendment both filed 11-19-01 is acknowledged. Claims 36 and 44-46 have been canceled, new claims 47-51 have been added and claims 1, 34, and 37 have been amended as requested. Claims 1-35, 37-39, and 47-51 are pending.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Smith et al (5,414,124; hereafter '124).

'124 discloses germicidal compositions comprising about 50-80% of a quaternary ammonium compound in propylene glycol and water.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graubart et al (5,454,984; hereafter '984).

'984 teaches cleaning compositions comprising about 0.01 to about 10% of a quaternary ammonium compound in a polyglycol. "About 10%" includes amounts slightly greater than 10%, since it would have been obvious to one skilled in the art at the time of the invention to include amounts slightly greater than 10% to increase the antimicrobial and cleaning strength of the composition. Furthermore, a *prima facie* case

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of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner* 227 USPQ 773 MPEP 2144.05 I.

6. Claims 1-16, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graubart et al (5,454,984; hereafter '984) in combination with Lonza Bardac 2050 product sheet (2000), hereafter "Lonza".

'984 is relied upon for teaching that BARDAC-2050 is a well known quaternary ammonium formulation. Lonza is a teaching reference showing that Bardac 2050 is 50% quaternary ammonium chloride, 40% ethanol and 10% water. '984 and Lonza do not explicitly teach varying the amounts of the quaternary agent, ethanol or water, however manipulation of the amounts of these ingredients would have been obvious to one skilled in the art at the time of the invention to increase or decrease the amount of surfactant or antimicrobial properties desired in the formulation (i.e. greater cleaning power and antimicrobial properties, increase quaternary, and ethanol, diluted formulation, increase water with respect to the quaternary compound and ethanol).

7. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graubart et al (5,454,984; hereafter '984) in combination with Lonza Bardac 2050 product sheet (2000), hereafter "Lonza" and further in combination with Bansemir et al (5,030,659; hereafter '659).

'984 and Lonza are relied upon for all that they teach as stated previously.

'659 teaches that propylene glycol is an effective solvent for quaternary ammonium compounds.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to combine '984 and '659 and use both ethanol and propylene glycol as solvents for a quaternary ammonium compound based upon the motivation that less amounts of each solvent compared to that necessary for dissolution when used alone would be necessary since the two solvents would have an additive effect for dissolving the quaternary ammonium compound and the availability of the solvents.

8. Claims 1-21 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5,414,124; hereafter '124).

'124 discloses germicidal compositions comprising about 50-80% of a quaternary ammonium compound in propylene glycol and water.

'124 does not explicitly teach varying the amounts of the quaternary agent, propylene glycol or water according to the instant claims, however manipulation of the amounts of these ingredients would have been obvious to one skilled in the art at the time of the invention to increase or decrease the antimicrobial properties desired in the formulation (i.e. greater antimicrobial properties, increase quaternary, diluted formulation, increase water and propylene glycol with respect to the quaternary compound).

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9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5,414,124; hereafter '124) in view of The Merck Index (1985).

'124 is relied upon for all that it teaches as stated previously. '124 does not teach glycerol as a solvent for quaternary ammonium compounds.

The Merck Index teaches that propylene glycol and glycerol are substitutes for each other.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to substitute glycerol for the propylene glycol of '124.

10. Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (5,414,124; hereafter '124) in view of Gauvreau et al (3,787,566; hereafter '566).

'124 is relied upon for all that it teaches as stated previously. '124 does not teach the limitations of claims 25-30 where the quaternary ammonium compound is an alkylpyridinium salt, a tetra-alkylammonium salt, or an alkylalicyclic ammonium salt.

'566 is relied upon for teaching inclusion of cetyl pyridinium in disinfecting compositions.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to either include cetyl pyridinium in the composition of '124 for an additive disinfecting effect or substitute cetyl pyridinium for the quaternary ammonium compounds of '124 based upon the availability of the quaternary ammonium compound and the expectation that these compounds are antimicrobial.

11. Claims 31-35 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (5,405,604; hereafter '604) in view of Dickson (5,520,575; hereafter '575).

'604 teaches a concentrated mouth rinse comprising about 10% of a quaternary ammonium compound in a solvent comprising propylene glycol. '604 does not teach concentrations of the quaternary ammonium compound of about 40% by weight.

'575 is relied upon for teaching concentrations of antimicrobial agents from about 1% to about 30%.

### ***Response to Arguments***

12. Applicant's arguments filed 11-191-01 have been fully considered but they are not persuasive. Applicants argue that '575 teaches away from using an antimicrobial since it teaches that the wetting solution alone is capable of reducing the ability of contaminants to adhere to a surface. Therefore, '575 would not require the presence of an antimicrobial agent. However, column 4, lines 12-35 do not state that an antimicrobial is unnecessary and specifically states "In one embodiment of this invention, the "aqueous antimicrobial solution" is an aqueous solution comprising an antimicrobial agent" (C 4, L 14-16) and further elaborating that "the concentration of antimicrobial agent generally depends upon the particular agent or combination of agents and the degree of contamination of the carcass" (C 4, L 3-29-31). Clearly, this encourages use of antimicrobial agents and does not discourage one of ordinary skill in a path divergent from that taken by the applicant.

Applicants also argue that these claims do not contain flavoring oils as required by '604. Such a limitation is not present in the instant claims.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

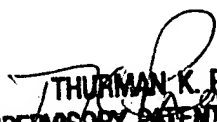
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

tw  
January 26, 2002

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600